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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gerard MOINET et al.

Examiner: Nancy L. Zhang

Serial No.: 10/501,069

Group Art Unit: 1614

Filed: July 9, 2004

Title: PHARMACEUTICAL COMPOSITION COMPRISING A GLITAZONE AND  
A4-OXOBUTANOIC ACID AND THE USE THEREOF FOR TREATING  
DIABETES

**RESPONSE TO REQUIREMENTS FOR RESTRICTION**  
**AND ELECTION OF SPECIES**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SIR:

In response to the Office Action mailed June 7, 2006, and the restriction requirement set forth therein, Applicants hereby elect Group I, claims 1-11, drawn to the compositions of glitazones and compounds of formula (I). The election is made with traverse for the reasons set forth below. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

The restriction requirement is traversed because there is no allegation or proof of a burden of search. The method of use claims of Group II depend upon the composition claims of Group I and, thus, require the particulars thereof. No burden of search is seen since a search of all the compositions would necessarily reveal all uses thereof.

The restriction is further traversed since the reasons for restriction do not meet the PTO requirements for restriction between such inventions. Groups I and II are related as composition

of matter and method of using that composition of matter. MPEP §806.05(h) allows for restriction between such groups of invention when: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. No proof of one of these requirements is provided or alleged in the Office Action. Thus, the restriction is not supported.

In response to the requirement for an election of species also set forth in the Office Action, applicants hereby elect the species of Group (A) wherein the composition comprises pioglitazone (recited in claims 7 and 8) as the glitazone and 2-benzyl-4-(4-fluorophenyl)-4-oxobutanoic acid (see second compound listed in claim 9) as the compound of formula (I). It is believed that claims 1-11 (of the elected invention pursuant to the restriction requirement above) all encompass the elected species.

The Examiner is encouraged to examine the broadest possible scope of invention indicated by the elected species. In accordance with M.P.E.P. §803.02, the Examiner is reminded that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. It would appear that the Office Action is in accordance with this manner of an election of species requirement.


However, the Office Action is confusing because it then goes on to apparently allege that each of the species lack unity of invention from each other. Thus, to the extent the election of species requirement is actually a disguised restriction requirement, applicants traverse such requirement. There is no proof provided that every species lacks unity of invention from every other species. The claims are drawn to compositions combining a glitazone and a compound of the formula (I). The glitazone compounds are all closely related to each other and the compounds of formula (I) share a common core and are closely related to each other. Thus, the claims are directed to a unique combination. There is no evidence of record to suggest that this combination does not provide a special technical feature defining over the prior art. The Office Action alleges that there is no shared special technical feature because different compounds and different enantiomers may have different properties. This is not a proper basis for finding lack of unity of invention. If this was the proper standard every species would always lack unity of

invention from every other species. This has never been and is not now the proper standard for finding lack of unity of invention. Applicants, therefore, request that the allegations of lack of unity of invention among the species be withdrawn.

Favorable action is earnestly solicited.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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